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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,781	02/06/2001	Jacques Theze	202930US0CIP	3255

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EXAMINER	
MERTZ, PREMA MARIA	
ART UNIT	**PAPER NUMBER**
1646	

DATE MAILED: 09/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/776,781	Theze et al.
Examiner	**Art Unit**
Prema Mertz	1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Aug 2, 2002* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-26* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-4, are drawn to an antibody which binds to a peptide of amino acid sequence of SEQ ID NO:2, classified in Class 530, subclass 387.9.

Group 2. Claims 1-4, are drawn to an antibody which binds to a peptide of amino acid sequence of SEQ ID NO:6, classified in Class 530, subclass 387.9.

Group 3. Claims 5, 10 are drawn to a DNA sequence encoding a peptide of SEQ ID NO:2 and a vector comprising the DNA, classified in Class 536, subclass 235.

Group 4. Claims 5, 10 are drawn to a DNA sequence encoding a peptide of SEQ ID NO:6 and a vector comprising the DNA, classified in Class 536, subclass 235.

Group 5. Claim 6 is drawn to a method of detecting in vitro the presence or activity of IL-2R using an antibody which binds to a peptide of amino acid sequence of SEQ ID NO:2, classified in Class 435, subclass 7.2.

Group 6. Claim 6 is drawn to a method of detecting in vitro the presence or activity of IL-2R using an antibody which binds to a peptide of amino acid sequence of SEQ ID NO:6, classified in Class 435, subclass 7.2.

Group 7. Claim 7 is drawn to a method of inhibiting the activity of IL-2R using a peptide of amino acid sequence of SEQ ID NO:2, classified in Class 514, subclass 12.

Group 8. Claim 7 is drawn to a method of inhibiting the activity of IL-2R using a peptide of amino acid sequence of SEQ ID NO:6, classified in Class 514, subclass 12.

Group 9. Claim 8 is drawn to a method of inhibiting the activity of IL-2R using an antibody to a peptide of amino acid sequence of SEQ ID NO:2, classified in Class 424, subclass 139.1.

Group 10. Claim 8 is drawn to a method of inhibiting the activity of IL-2R using an antibody to a peptide of amino acid sequence of SEQ ID NO:6, classified in Class 424, subclass 139.1.

Group 11. Claims 9, 12-14, are drawn to a method of using a peptide of amino acid sequence of SEQ ID NO:2, by administering the peptide to a patient to induce the activities of IL-2, classified in Class 514, subclass 12.

Group 12. Claims 9, 12-14, are drawn to a method of using a peptide of amino acid sequence of SEQ ID NO:6, by administering the peptide to a patient to induce the activities of IL-2, classified in Class 514, subclass 12.

Group 13. Claim 11 is drawn to a method of treating a patient by using a vector comprising the DNA encoding a peptide of amino acid sequence of SEQ ID NO:2, classified in Class 514, subclass 44.

Group 14. Claim 11 is drawn to a method of treating a patient by using a vector comprising the DNA encoding a peptide of amino acid sequence of SEQ ID NO:6, classified in Class 514, subclass 44.

Group 15. Claims 15-26, are drawn to a peptide of amino acid sequence of SEQ ID NO:2, classified in Class 530, subclass 324.

Group 16. Claims 15-26, are drawn to a peptide of amino acid sequence of SEQ ID NO:6, classified in Class 530, subclass 324.

Any change of amino acid residues at any one or more positions in a peptide sequence is considered, absent factual data to the contrary, a distinct peptide. Once one peptide sequence is selected (SEQ ID NO:2 or 6), the other peptide will be withdrawn from consideration.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-4 and 15-16 are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The polynucleotide of inventions 3-4 can be used to make hybridization probes or can be used in gene therapy as well as in the production of the proteins of interest. The peptides of inventions 15-16 can be used as probes, or used therapeutically or diagnostically, e.g. in screening. The antibodies of inventions I-2 can be used to obtain the polynucleotides of Groups 3-4 respectively, and can also be used in diagnostics, e.g. as a probe in immunoassays.

Inventions I and 3 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by

another and materially different process (MPEP. § 806.05(f)). In the instant case the protein can be prepared by materially different processes, such as by chemical synthesis.

Inventions 2 and 4 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP. § 806.05(f)). In the instant case the protein can be prepared by materially different processes, such as by chemical synthesis.

Inventions I and 13 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP. § 806.05(h)). In the instant case the product as claimed can be used as a hybridization probe.

Inventions 2 and 14 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP. § 806.05(h)). In the instant case the product as claimed can be used as a hybridization probe.

Inventions I and 5, 9, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as

claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention I can also be used in immunochromatography.

Inventions 2 and 6, 10, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention 2 can also be used in immunochromatography.

Inventions 15 and 7, 11, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention 15 can also be used as antigen in the production of antibodies.

Inventions 16 and 8, 12, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention 16 can also be used as antigen in the production of antibodies.

Inventions I and 6-8, 10-16 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 2 and 5, 7-9, 11-16 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 3 and 5-12, 14-16 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 4 and 5-13, 15-16 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 15 and 5-6, 8-10, 12-14, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 16 and 5-7, 9-11, 13-14, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP. § 806.04, MPEP. § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 5-14 are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP. § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP. § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz

Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
August 26, 2002